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NOTICE OF ALLOWANCE AND FEE(S) DUE

22801 7590 03/05/2004
LEE & HAYES PLLC
421 W RIVERSIDE AVENUE SUITE 500
SPOKANE, WA 99201

EXAMINER

PRIETO, BEATRIZ

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 03/05/2004

29

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,701	09/15/1999	ANOOP GUPTA	MS1-388US	7827

TITLE OF INVENTION: FACILITATING ANNOTATION CREATION AND NOTIFICATION VIA ELECTRONIC MAIL

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1330	\$300	\$1630	06/07/2004

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS** FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status is changed, pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above and notify the United States Patent and Trademark Office of the change in status, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check the box below and enclose the PUBLICATION FEE and 1/2 the ISSUE FEE shown above.

☐ Applicant claims SMALL ENTITY status.
See 37 CFR 1.27.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

7h

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: **Mail**

**Mail Stop ISSUE FEE
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INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 4 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Legibly mark-up with any corrections or use Block 1)

22801 7590 03/05/2004

**LEE & HAYES PLLC
421 W RIVERSIDE AVENUE SUITE 500
SPOKANE, WA 99201**

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

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APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
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nonprovisional NO \$1330 \$300 \$1630 06/07/2004

EXAMINER	ART UNIT	CLASS-SUBCLASS
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PRIETO, BEATRIZ 2142 709-206000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 _____
2 _____
3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. Inclusion of assignee data is only appropriate when an assignment has been previously submitted to the USPTO or is being submitted under separate cover. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent); ☐ individual ☐ corporation or other private group entity ☐ government

4a. The following fee(s) are enclosed:

- ☐ Issue Fee
☐ Publication Fee
☐ Advance Order - # of Copies _____

4b. Payment of Fee(s):

- ☐ A check in the amount of the fee(s) is enclosed.
☐ Payment by credit card. Form PTO-2038 is attached.
☐ The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

Director for Patents is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above.

(Authorized Signature)

(Date)

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Alexandria, Virginia 22313-1450.

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LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			PRIETO, BEATRIZ	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 03/05/2004

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 0 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 0 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) system (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (703) 305-1383. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

Notice of Allowability

Application No.

09/396,701

Examiner

B. Prieto

Applicant(s)

GUPTA ET AL.

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 2/3/04.
2. ☒ The allowed claim(s) is/are 1-5, 13-25, 27-33, and 35-42.
3. ☒ The drawings filed on 15 September 1999 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>14 - 22</u> | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

Notice of Allowability Supplemental

Reason for allowance

1. The following is the Examiner's statement of Reason for Allowance. The prior art of record teaches the claimed invention substantially as claimed, however fails to teach or suggest individually or in combination the following limitations of the claimed invention; Regarding claims 1, and 3-5, prior art does not teach generating new annotation that include display located content data in an e-mail message, because the claimed term "new annotation" means that it is not based on existing annotation data, as in taught in the Hou reference. Thereby, generating a new annotation, which is not based on existing annotation data, is not taught by the prior art of record (as argued on pages 9-10 of brief). Prior art fails to teach analyzing an e-mail messages that are received not in reply to a previous mail message that included annotation data, because the Hou reference's annotation handler allows a new annotation to be made that is a reply to a selected segment from an e-mail message opened and retrieved from an mailbox database ("report") and then it generates the email message, however fails to teach where the e-mail is not in reply to a previous e-mail message. Thereby, analyzing an e-mail messages that are received not in reply to a previous mail message, is not taught by the prior art, hence claims 1, 3-5 are distinguishable over the prior art (as argued on pages 9-10 of brief). Regarding claim 17-25 and 27-30, prior art fails to teach wherein media content is being access for rendering to a user, beginning with the one of a plurality of temporal segments of the media content that corresponds to a new annotation, because the claimed clause "media content being accessed for rendering to a user", means rendering at a particular location of a media content, that is, the Birrell reference does not teach rendering media content (not bit) at a particular location, as recited in claim 17. Thereby claims 17-25 and 27-30 are distinguishable over the prior art (as argued on page 16 of brief). Regarding claims 31 and 32, prior art fails to teach displaying a default recipient corresponding to the identified one or more annotation sets, that is to receive an e-mail notification. Hou's markers that that used to specify annotations segments for playing back or for reply segments, represented by voice-silence markers, are not analogous to claimed annotation sets, nor those the Hou reference teach a "default recipient to receive an e-mail", because the mail report handles including the searched and displayed mailing list in the reference used to

deliver created e-mail does not correspond to an identified one or more of annotation sets, as claimed. Thereby, prior art fails to teach displaying a default recipient, corresponding to identify one or more annotations sets, as recited on claim 31. Regarding claims 33 and 35-36, prior art does not teach claim limitation as recited, creating after the plurality of electronic mail messages have been included in the e-mail thread, a plurality of annotations from the plurality of e-mail messages in the e-mail thread, as recited in claim 3, wherein the claimed limitation "creating plurality of annotations from the plurality of e-mail" is not analogous to prior arts adding and removing of labels (e.g. annotations) a plurality of e-mail messages, because the Birrell does not teach creating labels from a plurality of e-mail messages in an electronic mail thread. Thereby, prior art fails to teach the features of claims 33, and 35-36 (as argued on pages 19-20). Regarding claims 13-16 and 40, prior art does not teach an installation option in an e-mail that identifies an installation program for installing modules allowing content of new annotation included in the e-mail as well as the corresponding media content to be rendered. Prior art (Russell) teaches installation modules for allowing content to be displayed or rendered, Birrell teach email messages having annotations including media content, installation options in the form of files or programs such as applets or plug-ins or Java applets files downloadable over the network, these programs for rendering multimedia content, where the media content is included in e-mail messages to be rendered by the applet or installation option, however prior art does not teach where the installation option is included in an e-mail message, thereby the limitation of claim 13 are distinguishable over the prior art of record (as argued on pages 24-25). The limitations above discussed are those set forth on independent claim **1, 13, 17, 23, 25, 31, 33, 37 and 41**. Claims are allowed because of the combination of other limitations and the limitation listed above.

5. Claims **1-5, 13-25, 27-33, and 35-42** are allowed because of the combinations of other limitations and the limitation listed above.

6. Any comments Applicants considers necessary must be submitted no later than the payment of the Issue Fee and to avoid processing delays, should preferable accompany the Issue Fees. Such submission should be clearly labeled " Comments on Statement of Reasons for

Allowance". In event of any post-allowance papers (e.g. IDS, 312 amendment, petition, etc.), Applicant is exhorted to mail papers to the Production Control branch in Publications or faxed to post-allowance papers correspondence branch at (703) 308-5864 to expedite issuing process or call PUB's Customer Service if any questions at (703) 305-8497.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **B. Prieto** whose telephone number is **(703) 305-0750**. The Examiner can normally be reached on Monday-Friday from 6:30 to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, David Wiley can be reached on **(703) 308-5221**. The fax phone number for the organization where this application or proceeding is assigned is **(703) 872-9306**. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703) 305-3800/4700**.

Any response to this action should be mailed to:

Box Issue Fee
Commissioner of Patents and Trademarks
Washington, D.C. 20231


or faxed to:


(703) 746-4000, (Issue Fee and any Publication fee/payments)

Or:

(703) 305-8283 (for checking on receipt of payment w/Publication)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Fourth Floor (Receptionist), further ensuring that a receipt is provided stamped "Technology Center 2100".


B. Prieto
Patent Examiner


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER